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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/266,155	03/10/1999	BURTON J. PRICE	MRA-PT001	5381
3624	7590	04/06/2004	EXAMINER	
VOLPE AND KOENIG, P.C. UNITED PLAZA, SUITE 1600 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103			JUSKA, CHERYL ANN	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

<b>Office Action Summary</b>	<b>Application No.</b> 09/266,155	<b>Applicant(s)</b> PRICE ET AL.	
	<b>Examiner</b> Cheryl Juska	<b>Art Unit</b> 1771	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-9, 11-14, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-9, 11-14, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed January 15, 2004, has been entered. Claims 7, 9, 13, 16, and 17 have been amended as requested. The pending claims are 7-9, 11-14, 16, and 17.

2. Applicant's amendment to claim 9 is sufficient to withdraw the 102/103 rejection of claims 9, 11, and 12 by the Sorrells patent, as set forth in section 5 of the last Office Action. Specifically, claim 9 has been amended to limit the shape of the claimed panel to correspond to a predetermined shape of an interior surface of a motor vehicle. Since Sorrells does not explicitly teach a panel in the shape of a motor vehicle interior, said rejection is hereby withdrawn.

However, a new 103 rejection is set forth below.

### ***Claim Rejections - 35 USC § 102/103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 7 and 8 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 4,112,161 issued to Sorrells.

Applicant amendment to claim 7 wherein the polymeric material is "wicked into" the textile tufts rather than the previously claimed "disposed in" is insufficient to overcome the standing rejection. Specifically, the result of wicking polymeric material into the textile backing is that said polymeric material is disposed in the textile tufts. In other words, the new method

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limitation of wicking is insufficient to overcome the art rejection since method limitations in product claims are only given weight to the extent that the final product is materially effected.

5. Claims 13, 14, 16, and 17 stand rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as obvious over the cited Sorrells patent.

Applicant has amended independent claims 13, 16, and 17 to include the preamble limitation that the claimed product is "for use in a motor vehicle." Applicant asserts that this phrase breathes life into the claim. The examiner respectfully disagrees. Said phrase is merely a recitation of the intended use of the claimed invention. An intended use recitation must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Specifically, the textile laminate of Sorrells is capable of use in a motor vehicle. [Note the recitation of "use in a motor vehicle" does not limit the laminate to a shaped panel corresponding to the interior of a motor vehicle.] Therefore, claims 13, 14, 16, and 17 stand rejected.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 9, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Sorrells patent.

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Said claims were previously rejected under 102/103, but are now rejected under 103 as being obvious over Sorrells. Specifically, Sorrells does not explicitly teach the claimed motor vehicle panel shape. However, it would have been obvious to one skilled in the art to merely change the shape of the Sorrells laminate to suit a particular end use. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey* 149 USPQ 47. Therefore, claims 9, 11, and 12 are rejected.

#### ***Response to Arguments***

8. Applicant's arguments filed on with the amendment of January 15, 2004 have been fully considered but they are not persuasive.

9. Specifically, Applicant traverses the rejection of claims 7 and 8 by asserting that Sorrells does not teach the presently claimed "wicked into" recitation. It appears applicant intends said recitation to limit the disposed polymeric material and the voids therebetween to being formed by a step of reheating the polymeric material after it is applied to the tufted backing. [Note specification, page 7.] However, since applicant has not explicitly defined "wicked into" in the specification, this recitation is read in its broadest sense and not limited to a wicking by means of a reheating step. Therefore, applicant's argument is unpersuasive and the rejection is maintained as argued above.

10. It is suggested, to overcome the art of record, applicant amend the independent claims with a method limitation that describes the reheating step that produces the wicking in and void formation of the polymeric material. Such a method step limitation would be given patentable

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weight in that the process produces a specific structure that cannot be obtained from the method of Sorrells (i.e., perforating the polymeric material).

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CHERYL A. JUSKA  
PRIMARY EXAMINER

cj  
April 1, 2004